

REMARKS

Claims 6, 15, 19, 27 and 32 are amended, and new claims 34-38 are added through this Amendment. Thus, claims 2-38 are pending in this application. The Applicants have carefully and thoughtfully considered the Office Action and the comments therein. Each of the pending claims is believed to define an invention that is novel and unobvious over the cited references. Based on the foregoing amendment and the following remarks, it is respectfully submitted that the instant application is in condition for allowance. Prompt reconsideration and withdrawal of the rejections is earnestly requested.

1. On pages 2-3 of the Office Action, claim 15 is rejection under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Specifically, the Action states that claim 15 is directed to an abstract idea because “the multi-dimensional matrix from which financial strategies are determined is actually a logical representation of what some particular data represents, and that method steps recited in the claim are not capable of being functionally performed by an apparatus or person.” This rejection is respectfully traversed for two reasons.

First, in order to satisfy the requirement of 35 U.S.C § 101, a process need not include tangible steps in achieving a result. Instead, what is required is for the process to include “a useful, concrete and tangible **result**.” *State Street State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 149 F.3d 1368, 1373-74 (emphasis added). The “selecting at least one of the financial strategies to meet the financial goals using a software-implemented decision analysis and the outcomes for the financial strategies”, as recited in claim 15, is a useful, concrete, and tangible result. Accordingly, claim 15 is believed to satisfy the requirement of 35 U.S.C. § 101.

Secondly, although claim 15 is believed to be in compliance with 35 U.S.C. § 101, in order to expedite the prosecution of the instant application, claim 15 has been amended to recite in part “A computer-implemented method.” The method is recited as being computer-implemented, which counters the assertion on page 3 of the Office Action that “method steps recited in the claim are not capable of being functionally performed by an apparatus or person.” Support for the amendment can be found, for example, in the Specification on page 4, lines 3-6 and page 59, lines 4-11. Claim 15 has also been amended to recite “each financial strategy is determined using a multi-dimensional matrix of at least one financial variable and stored on a computer-readable medium.” A financial strategy stored on a computer-readable medium is a tangible object, rather than a mere abstract representation of data. Support for this amendment can be found, for example, in the Specification on page 8, lines 15-16. Therefore, it is respectfully submitted that amended claim 15 satisfies the requirement of 35 U.S.C. § 101. Reconsideration of the claim and withdrawal of the rejection is respectfully requested.

2. On pages 3-4 of the Office Action, claims 6 and 15 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

Regarding claim 6, the Office Action states that the enumerated steps “are for the purpose of determining a goals hierarchy and obtaining an MUF for said hierarchy” and suggests an amendment. Applicants thank the Examiner for his careful reading and suggestion. Claim 6 has been amended accordingly. It is respectfully submitted that the amended claim 6 overcomes the rejection under 35 U.S.C. § 112, second paragraph.

Regarding claim 15, the Action states that “Claim 15 appears to relate to a logical representation of what some particular data represents, in that the multi-dimensional matrix from which financial strategies are determined cannot [be] functionally performed by an apparatus or person.” As previously stated, claim 15 has been amended to recite in part “A computer-implemented method” and “each financial strategy is determined using a multi-dimensional matrix of at least one financial variable and stored on a computer-readable medium.” The method is recited as being computer-implemented, which counters the assertion on page 4 of the Office Action that “the multi-dimensional matrix from which financial strategies are determined cannot [be] functionally performed by an apparatus or person.” Furthermore, a financial strategy stored on a computer-readable medium is functionally executable on a computer apparatus. Therefore, it is submitted that the amended claim 15 overcomes the rejection under 35 U.S.C. § 112, second paragraph. Reconsideration of claims 6 and 15 and withdrawal of the rejection is respectfully requested.

3. On pages 4-8 of the Office Action, claims 2-3, 9-13, 15-17, 19, 21-27, and 29-31 are rejected under 35 U.S.C. § 102(e) as being unpatentable over U.S. Patent No. 6,985,880 to Hodgon et al. (hereinafter “Hodgon”). These rejections are respectfully traversed.

A. Declaration Under 37 C.F.R. § 1.131

Applicants are filing a Declaration under 37 C.F.R. § 1.131 concurrent with this amendment, declaring that the Applicants conceived and reduced to practice the invention described and claimed in this application prior to Hodgon’s effective filing date of March 1, 1999. It is respectfully submitted that upon the entry of the Declaration, the rejections over

Hodgon are moot and should be withdrawn. Accordingly, allowance of claims 2-3, 9-13, 15-17, 19, 21-27 and 29-31 is requested upon the entry of the accompanying Declaration under 37 C.F.R § 1.131.

B. Traversal of Rejection over Hodgon

Notwithstanding the accompanying Declaration under 37 C.F.R. § 1.131, it is respectfully submitted that claims 2-3, 9-13, 15-17, 19, 21-27, and 29-31 are patentably distinct over Hodgon.

As per claim 2, a method is recited for determining at least one financial strategy for assets to meet financial goals. The method comprises the steps of determining an outcome for each of a plurality of financial strategies, and selecting at least one of the financial strategies to meet the financial goals using a software-implemented decision analysis and the outcomes for the financial strategies. Hodgon fails to teach all the limitations of claim 2 for the reasons stated below.

Hodgon teaches a system and method of achieving a recommended asset allocation and withdrawal strategy, in which a SELIGMAN HARVESTER® Workbook is presented to a client, who completes a workbook to help identify the client's total investable assets, the total necessary expenses (i.e., needs), and the total discretionary expenses (i.e., wants). Hodgon, Col. 11: 6-36 and FIGs. 1A-1D. Hodgon then uses these data to calculate a fixed-dollar withdrawal amount as the percentage of investment assets required for needs and a fixed-percent withdrawal amount as the percentage of investment assets required for wants. Hodgon, Col. 11: 37 to Col. 12: 39. Based on the calculated fixed-dollar withdrawal amount and the fixed-percent withdrawal amount, the financial advisor then determines a specific asset allocation and withdrawal strategy for the client. Hodgon, Col. 12: 40-50, and FIG. 2B. Thereafter, a Hypothetical Illustrator,

which is a software program, is used to generate a hypothetical illustration of the distribution of possible portfolio values and withdrawal amounts for the asset allocation and withdrawal strategy selected by the financial advisor. Hodgon, Col. 12: 57-64 and Col. 13: 2-7. This will help the financial advisors to facilitate a recommended asset and withdrawal strategy for the client. Hodgon, Col. 13: 2-7.

Hodgon fails to teach “selecting at least one of the financial strategies to meet the financial goals using a software-implemented decision analysis.” In rejecting claim 2, the Office Action aligns the recited “selecting at least one of the financial strategies to meet the financial goals using a software-implemented decision analysis” with Hodgon’s teaching of a financial advisor determining a specific asset allocation and withdrawal strategy based on the workbook and using the Hypothetical Illustrator to obtain a recommended asset allocation and withdrawal strategy. Although the Hypothetical Illustrator is a software program, its only task is to illustrate hypothetical portfolio distribution and withdrawal amounts for the financial strategies **selected by the financial advisor**. Specifically, the Hypothetical Illustrator requires the **financial advisor** to input the client’s fixed dollar withdrawal, fixed percent withdrawal, asset allocation, and withdrawal strategy, and uses that input to search its worksheet for a match that projects a hypothetical illustration of a distribution of possible withdrawal amounts or portfolio values. Hodgon, Col. 13: 15-45. The asset allocation and withdrawal strategy, which together amount to a financial strategy, are selected by the **financial advisor, not the software**. Hodgon, Col. 12: 40-50, and FIG. 2B. Thus, the Hypothetical Illustrator does not teach or disclose a software-implemented decision analysis used for selecting a financial strategy. In contrast, Hodgon teaches **manual** selection of the financial strategies by the financial advisor and using the Hypothetical Illustrator only to illustrate possible withdrawal amounts or portfolio values for the

selected strategies. Hodgon, Col. 13: 2-8 and Col. 13: 24-35. For at least this reason, it is submitted that claim 2 is allowable over Hodgon. Reconsideration of claim 2 and withdrawal of the rejection is respectfully requested.

Claims 3, 11-13, 15-16, 21 and 23 all recite in part “selecting at least one of the financial strategies to meet the financial goals using a software-implemented decision analysis”.

Therefore, for at least the reasons provided above, claims 3, 11-13, 15-16, 19, 21 and 23 are submitted as allowable over Hodgon.

Claims 17, 19, 22 and 24 depend on claims 16, 2, 21 and 23, respectively. Therefore, for at least the same reasons, claims 17, 19, 22 and 24 are submitted as allowable over Hodgon.

A per claim 29, a computer system for determining at least one financial strategy for assets to meet financial goals is recited, the system comprising, among other features, “a software-implemented projection engine for determining an outcome for each of the financial strategies using the investor information”. Therefore, for at least the reasons provided above, claim 29 is submitted as allowable over Hodgon.

Claim 30 recites an information storage device embodying a questionnaire, the questionnaire for determining at least one financial strategy which is “determined using Monte Carlo simulations of a plurality of the financial strategies and software-implemented decision analysis employing multi-attribute utility theory”. Similarly, claim 31 recites an information storage device embodying a report, the report for determining at least one financial strategy which is “determined using Monte Carlo simulations of a plurality of the financial strategies and software-implemented decision analysis employing multi-attribute utility theory”. Therefore, for at least the reasons provided above, claims 30 and 31 are submitted as allowable over Hodgon.

Claims 9-10 and 25-26 are rejected as anticipated by Hodgon. However, claims 9-10 and 25-26 are dependent on claim 20, which itself is rejected under 35 U.S.C. § 103(a) as unpatentable over Hodgon. It is submitted that upon allowance of claim 20, claims 9-10 and 25-26 are allowable over Hodgon.

4. On pages 8-12 of the Office Action, claims 4-8, 14, 18, 20, 28, and 32-33 are rejected under 35 U.S.C. § 103(a) as unpatentable over Hodgon. These rejections are respectfully traversed.

A. Declaration Under 37 C.F.R. § 1.131

As stated above, Applicants are filing a Declaration under 37 C.F.R. § 1.131 concurrent with this amendment, declaring that the Applicants conceived and reduced to practice the invention described and claimed in this application prior to Hodgon's effective filing date of March 1, 1999. It is respectfully submitted that upon the entry of the Declaration, the rejections over Hodgon are moot and should be withdrawn. Accordingly, allowance of claims 4-8, 14, 18, 20, 28, and 32-33 is requested upon the entry of the accompanying Declaration under 37 C.F.R. § 1.131.

B. Traversal of Rejection over Hodgon

Notwithstanding the accompanying Declaration under 37 C.F.R. § 1.131, it is respectfully submitted that claims 4-8, 14, 18, 20, 28, and 32-33 are patentably distinct over Hodgon.

Claim 4 recites a method comprising, among other features, "selecting at least one of the financial strategies ... using a software-implemented decision analysis..., wherein the software-

implemented decision analysis uses multi-attribute utility theory.” Similarly, claim 28 recites a method comprising, among other features, “selecting at least one of the financial strategies ... using software-implemented multi-attribute utility theory.” As previously provided, using a software-implemented decision analysis is neither taught nor suggested by Hodgon. Furthermore, even if MAUT is readily known in the related art, using a software-implemented analysis that uses MAUT to select at least one financial strategy is not taught or suggested by Hodgon. Accordingly, for at least the reasons previously provided above, claims 4 and 28 are submitted as allowable over Hodgon.

Claims 5-8 and 32 depend, directly or indirectly, on claim 4. Therefore, for at least the same reasons provided above, claims 5-8 are submitted as allowable over Hodgon. Claim 33 is dependent on claim 32 and is submitted as allowable for at least the same reason.

Claim 18 is dependent on claim 16, which is submitted as allowable. Therefore, it is submitted that claim 18 is allowable upon allowance of claim 16.

Claim 20 recites a method comprising, among other features, “selecting at least one of the financial strategies ... using a software-implemented decision analysis....” Therefore, for at least the reasons provided above, claim 20 is submitted as allowable over Hodgon.

5. New claims 34-36 are dependent, directly or indirectly, on claim 4 and recite features similar to claims 19, 31 and 32, respectively. Also, new claims 37-38 depend from claims 2 and 4 and recite a “computer-readable medium having software for performing the method” of claims 2 and 4, respectively. It is respectfully submitted that new claims 34-38 are supported by the Specification and add no new matter. Further, new claims 34-38 are allowable for at least being dependent on an allowable claim. Allowance of claims 34-38 is respectfully requested.

THEREFORE, because all rejections have been overcome, it is submitted that claims 2-36 are allowable and such allowance is requested.

Respectfully submitted,

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Michael A. Sartori, Ph.D.

Registration No. 41,289

Venable LLP

P.O. Box 34385

Washington, DC 20043-9998

Telephone: (202) 344-4000

Telefax: (202) 344-8300

MAS/ARR
DC2-829550